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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,646	10/09/2001	Tetsuo Nishikawa	Nanjo C-1	6210

7590 03/16/2004

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EXAMINER
SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/973,646	NISHIKAWA ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,3-7,12 and 16-19*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' arguments and 1.132 declaration filed 2/26/04 have been fully considered but they are not persuasive.

(a) With respect to the rejection of record utilizing Sakaki et al. (U.S. 6,364,422), it is noted that previously applicants argued that US 6,364,422 is not available as a reference against the present claims given that the thermoplastic resin composition disclosed in US 6,364,422 was disclosed by the present inventors. As evidence to support this position, applicants submitted a 1.132 declaration on 10/14/03.

The examiner noted that US 6,364,422 named three co-inventors, Sakaki, Kadomaru, and Mizoguchi, two of which, namely, Sakaki and Mizoguchi are inventors of the present application and that in the 1.132 declaration of 10/14/03 three of the four co-inventors of the present application, namely, Sakaki, Mizoguchi, and Nishikawa, state that they are the true inventors of the thermoplastic resin composition of US 6,364,422. The examiner stated that the 1.132 declaration did not provide a satisfactory showing to establish that the inventors of the present application are the sole inventors of the subject matter in US 6,364,422 given that there was no disclosure regarding the fourth co-inventor of the present application, namely, Haruta.

In response, applicants have filed a second 1.132 declaration on 2/26/04 identical to that of the first declaration but signed by Mr. Haruta. While examiner appreciates the submission of such declaration in response to the position set forth in the previous office action, it is noted that

the declarations of 10/14/03 and 2/26/04 are still not successful in removing US 6,364,422 as a reference against the present claims for the following reasons.

Firstly, both declarations, i.e. the 10/14/03 declaration signed by Sakaki, Mizoguchi, and Nishikawa and the 2/26/04 declaration signed by Haruta, both state in the first line "We, the undersigned, hereby declare as follows:" and throughout the remainder of the declaration refer to "we" rather than the actual names of the inventors. The 10/14/03 declaration makes no reference to Haruta while the 2/26/04 reference makes no reference to Sakaki, Mizoguchi, and Nishikawa. Thus, there is no indication in either declaration that the "we" collectively refers to all four inventors, i.e. Sakaki, Mizoguchi, Nishikawa, and Haruta, of the present invention. Rather, the 10/14/03 declaration states that Sakaki, Mizoguchi, and Nishikawa are the true inventors of US 6,364,422 while the 2/26/04 declaration states that Haruta is the true inventor of US 6,364,422. There is no disclosure in either declaration that Sakaki, Mizoguchi, Nishikawa, and Haruta are the true inventors of US 6,364,422.

Thus, the declaration of 10/14/03 or the declaration of 2/26/04, either alone or in combination, does not provide a satisfactory showing to establish that the inventors of the present application are the sole inventors of the subject matter in US 6,364,422.

Further, as previously set forth in the paragraph bridging pages 4-5 of the office action mailed 12/23/03, there is confusion regarding lines 2-4 on page 2 of each of the 1.132 declarations. Specifically, this portion of the declaration states that the "entitled Balance Weight for Vehicle Wheel was invented independently by the inventors of U.S. Patent No. 6,364,422". This statement appears to contradict the rest of the declaration. That is, the declaration is made to establish the inventors of the present application are the true inventors of US 6,364,422,

however, by stating that US 6,364,422 was invented "independently" by the inventors of US 6,364,422, namely, Sakaki, Kadomaru, and Mizoguchi, it appears that the inventors of the present application are not the true inventors of US 6,364,422 which as disclosed by applicants was invented "independently" by Sakaki, Kadomaru, and Mizoguchi.

(b) With respect to the rejections of record utilizing Gallucci et al. (U.S. 6,300,399) applicants argue that Gallucci et al. is not available as a reference against the present claims in light of Japanese patent application 11-95712 which establishes that the present inventors had invented the claimed subject matter of the present invention prior to the effective filing date of Gallucci et al.

In response to examiner's previous argument that the present application does not claim priority to JP 11-95712 and thus, applicants cannot rely on the filing date of this reference to overcome Gallucci et al., applicants argue that even though applicants cannot claim the benefit of JP 11-95712, the Japanese application shows that applicants have reduced to practice the claimed subject matter of the present invention at least as of the filing date of 4/3/99.

However, examiner's position remains the same as set forth in the office action mailed 12/23/03. Given that the present application does not claim priority to JP 11-95712, applicants cannot rely on the filing date of this reference to overcome Gallucci et al. If the examiner were to agree with applicants' position that the filing date of JP 11-95712 allows applicants to swear behind the filing date of Gallucci et al., that would be equivalent to granting the present application priority under 35 USC 119(a)-(d) to which applicants are not entitled.

In light of the above, the rejections of record as set forth in paragraphs 3-4 and 6-7 of the office action mailed 12/23/03 remain applicable against the present claims.

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/10/04